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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,054	06/27/2003	Michael L.F. Chan	TRA-007	7895
3897	7590	11/06/2006	EXAMINER	
SCHNECK & SCHNECK P.O. BOX 2-E SAN JOSE, CA 95109-0005			MILLER, BENA B	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 11/06/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/608,054  
Filing Date: June 27, 2003  
Appellant(s): CHAN, MICHAEL L.F.

**MAILED**  
**NOV 06 2006**  
**GROUP 3700**

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Mr. Thomas Schneck  
For Appellant

### **EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 8, 2006 appealing from the Office action mailed February 22, 2006**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

#### **(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

#### **(3) Status of Claims**

This appeal involves claim 19.

#### **(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 07/25/06 has been entered.

#### **(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

1,860,586

McILHenney

05-1932

**(9) Grounds of Rejection**

The grounds of rejections are fully set forth in the Final Rejection (2/22/06) and are incorporated herein in its entirety by reference.

**(10) Response to Argument**

In response to Appellant's first argument that McILHenney fails to teach an "inner box of rectangular cross section with opposed top and bottom sections", the Examiner has pointed out in the Final Rejection that the inner box of McILHenney consists of the tubular member 12 and the transparent paper 11, in which the paper entirely wraps and seals tubular member 12. The inner box has a top section (the top surface defined by transparent paper 12) and a bottom section (the bottom surface defined by transparent paper 12). This combination clearly teaches a "rectangular cross section with opposed top and bottom sections" (Note: Figure 4). The Appellant further argues that the Examiner has asserted that tubular member is an inner box. The inner box is not defined only by the tubular member 12 but instead, the tubular member 12 and transparent sheet 11, as noted above. The Examiner contends that the device of McILHenney meets the claimed inner box.

In response to Appellant's second argument that the tubular member is not a box and fails to teach a flat base, sides and a lid, it is noted that the limitations on which the Appellant relies are not stated in the claim. As noted above, the inner box is defined by the combination of the tubular member 12 and transparent sheet 11.

In response to Appellant's third argument that McILHenney fails to teach "the inner box having a transparent wall through which said gift is visible". McILHenney teaches a transparent wall as defined by the top surface of transparent paper 11. The transparent sheet 11 allows one to view a gift, in this instance candy, in the inner box as clearly seen in Figure 6. Appellant further argues in par. 3 of page 9 through page 10, that the transparent sheet is not a transparent wall. Because the transparent paper covers the tubular member, does not prevent the transparent paper to act as a wall when covering or wrapped and sealed about the tubular member. Therefore, the Examiner contends that the transparent paper provides a transparent wall when wrapped and sealed about the tubular member.

In response to Appellant's fourth argument that the Declaration submitted provides a showing of commercial success, the Examiner contends that the Appellant has not established a nexus between the claimed invention and evidence of commercial success. First, the Appellant has not demonstrated that the sold approximately 10,000 gift display boxes was due to the claimed subject matter. Secondly, the Appellant stated that the 10,000 gift display boxes were sold by advertisement of a catalogue. However, this does not establish the evidence of commercial success. For example only, the order catalogue could have been sent to 1 million people and only 10,000 of the people might have purchased the product from the catalogue. This advertisement of the product in the order catalogue does not provide enough evidence to establish commercial success. Finally, Appellant has failed to show evidence that the claimed product has outsold similar typed products in industry sales. In this instance, the

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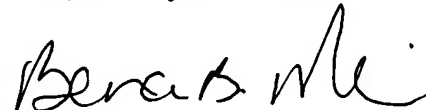
Appellant has not provided any evidence by data collection that the product has outsold similar typed products in industry sales. For the reasons noted above, it is believed that the Appellant has not established a nexus between the claimed invention and evidence of commercial success.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Bena Miller

**BENA MILLER  
PRIMARY EXAMINER**

Conferees:

Lowell Larson, Dmitry Suhol, Bena Miller

